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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,779	04/28/2000	Danne L. Buchanan	7905-15	5156

22428 7590 10/31/2003		EXAMINER
FOLEY AND LARDNER		NGUYEN, NGA B
SUITE 500		

ART UNIT	PAPER NUMBER
3628	

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/560,779	BUCHANAN ET AL.
	Examiner	**Art Unit**
	Nga B. Nguyen	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 August 2003</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-139</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-46,61-74,89-102,117 and 118</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>47-60,75-88,103-116 and 119-139</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>13,16,17</u>.	6) ☐ Other: .

DETAILED ACTION

1.   This Office Action is the answer to the Amendment filed on August 5, 2003,

which paper has been placed of record in the file.

2.   Claims 134-139 have been added. Claims 47-60, 75-88, 103-116 and 119-139

are elected for consideration.

Response to Arguments/Amendment

3.   Applicant's arguments with respect to claims 47-60, 75-88, 103-116 and 119-

139 have been considered but are moot in view of the new grounds of rejection.

4.   Applicant's amendment necessitated the new grounds of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 47-60, 75-88, 103-116 and 119-139 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Geer, U.S. Patent No. 5,930,778 in view of Cahill et al

(hereinafter Cahill), U.S. Patent No. 5,940,844.

Regarding to claim 47, Geer discloses a method for deposit processing at a

central site a plurality of original checks deposited at a remote site with accompanying

deposit information, comprising the steps of:

receiving information including a deposit account designation and where a

plurality of checks from different third parties are being deposited by a single depositor a

deposit sum, and electronic check data and original check image data for a plurality of

checks to be deposited (column 11, lines 1-11);

if no errors are identified, sending endorsement and/or voiding authorization to

the remote site (column 12, lines 31);

receiving endorsement data (column 11, lines 40-45);

providing the electronic deposit data to an accounting system for a bank of first

deposit (column 9, lines 25-30)

sorting the associated received data (column 9, lines 25-30);

transmitting associate electronic check data and the original check image data

and/or the endorsed and/or voided check image data directly or indirectly to a maker

bank or a print site associated therewith (column 9, lines 37-50).

Geer does not disclose identifying MICR errors and/or image data errors in the electronic check data received; if MICR and/or image data errors are identified in the electronic data, then sending an instruction to the remote sited to correct the errors; associating the endorsed and voided check image data with the original check image data. However, Cahill discloses identifying MICR errors and/or image data errors in the electronic check data received; if MICR and/or image data errors are identified in the electronic data, then sending an instruction to the remote sited to correct the errors (column 19, line 5-column 20, lines 10), associating the endorsed and voided check image data with the original check image data (column 2, line 52-column 3, line 15 and column 6, lines 40-50); and sorting the associated received data (column 12, lines 50-56). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to include the features above for the purpose of cost saving and time consuming, because it eliminates the use of paper checks.

Regarding to claim 48, Geer discloses sending the electronic check data and the original check image data to a bank of first deposit (column 9, lines 10-13).

Regarding to claim 49, Geer discloses the receiving step comprises: receiving electronic deposit data, electronic check data and original check image data for a plurality of different deposit transactions, the checks for each one of the plurality of different deposit transactions to be deposited at a different bank of first deposit; and sending each one of a plurality of the different deposit transactions to a respective different bank of first deposit (column 9, lines 10-13).

Regarding to claim 50, Geer discloses reading original check image data to create image information data; and comparing the image information data to the electronic check data (column 8, lines 59-67).

Regarding to claim 51, Cahill discloses storing at least one of the original check image data and the endorsement/or voided check image data on a server accessible from the Internet (column 31, line 45-column 32, line 5). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to include the features above for the purpose of cost saving and time consuming, because it eliminates the use of paper checks.

Regarding to claims 52, 53, 57, Geer does not disclose determining if a bank of first deposit is a maker bank for the original check; determining if the maker bank requires a hard copy of the original check; and if it does, sending the original check image data to a print site for printing and sending directly or indirectly to the maker bank; and if it does not, sending the original check image data directly or indirectly to the maker bank; and if it is the maker bank. However, it is well-known in the art of processing checks to determining if a bank of first deposit is a maker bank for the original check; determining if the maker bank requires a hard copy of the check. Moreover, Cahill teaches if the maker bank requires a hard copy of the check sending the original check image data to a print site for printing and sending directly or indirectly to the maker bank (column 45, line 10). Therefore, it would have been obvious to include that feature with Geer's for the purpose of time consuming, because it eliminates the use of paper checks.

Regarding to claim 54, Cahill discloses if the original check image data is inaccurate or unreadable, then sending the instruction to the remote site to correct without first storing at the central site the original check image data having the error; and receiving corrected original check image (column 19, line 60-column 20, line 10). Therefore, it would have been obvious to include that feature with Lowery for the purpose of discarding the error check image to free the storage space.

Regarding to claim 55, Geer discloses after receiving the data, sending an electronic notification to the remote site that a deposit is complete (column 9, lines 45-50).

Regarding to claim 56, Cahill discloses formatting the electronic check data and the original check image data for processing in an accounting system of the bank of first deposit (column 31, lines 20-30). Therefore, it would have been obvious to include that feature with Geer's for the purpose of time consuming, because it eliminates the use of paper checks.

Regarding to claim 58, Geer discloses receiving return check image data for a return check coupled with a reference key for an original deposit transaction (column 9, lines 45-50).

Regarding to claim 59, Geer discloses sending the return check image data with the reference key directly or indirectly to the maker bank for re-presentment (column 9, lines 45-50).

Regarding to claim 60, Geer discloses determining if a re-presentment of the returned check requires a duplicate hard copy of the return check or if the original check data image is acceptable for the re-presentment; and if the original check image is acceptable, obtaining a reference key associated with an original deposit transaction; and if the original check image is acceptable, obtaining a reference key associated with an original deposit transaction; and sending directly or indirectly the original check image data and the reference key to the maker bank (column 9, lines 45-50).

Regarding to claim 119, Geer discloses the method further comprise a system with a plurality of different remote sites, the following steps being performed at each of the plurality of remote sites: obtaining electronic deposit data for the one or more original checks; converting data for each of the one or more original checks into

electronic check data; creating an image of the one or more original checks to obtain original check image data; receiving endorsement and/or voiding authorization from an external site after receipt of the one or more checks; endorsing and/or voiding the original one or more checks to obtain endorsed and/or voided checks; electronically associating the electronic deposit data, the electronic check data and the original check image data; and transmitting the electronically associated electronic check data and the original check image data to the central site (column 6, line 40-column 7, line 61).

Regarding to claim 120, Geer discloses the transmitting to the central site step comprises transmitting the original check image data (column 9, lines 1-10).

Regarding to claim 121, Geer does not disclose determining if endorsement information one of the remote sites for printing on the check is up-to-date; and if the endorsement information at the remote site is not up-to-date, then downloading updated endorsement information from the central site. However, checking and obtaining the up-to-date endorsement information is well-known in the art of processing checks. Therefore, it would have been obvious to include that feature with Geer's for the purpose of ensuring of endorsement information is an up-to-date endorsement information.

Regarding to claim 122, Geer discloses comparing an amount of a deposit to an amount of one or more checks against a deposit maximum, and providing a rejection notice if the deposit exceeds the deposit maximum (column 9, lines 52-63).

Regarding to claim 123, Geer discloses receiving return check image data for a return check couple with a reference key for an original deposit transaction and a return reason (column 9, lines 45-50).

Regarding to claim 135, Geer discloses sending endorsement information to the remote site to be used to add and endorsement (column 11, lines 40-45).

Regarding to claim 138, Cahill discloses the step of transmitting the electronic check data and the check image data directly or indirectly to the maker bank or print site associate therewith transmit both the original check image data and endorsed and voided check image data directly or indirectly to the maker bank or a print site associated therewith (column 40, lines 1-15). Therefore, it would have been obvious to include that feature with Geer's for the purpose of retrieving the electronic image of the checks.

Claims 75-88, 124-128, 136, 139 are written in computer program product, claims 103-116, 129-134, 137 are written in apparatus, that parallel the limitations found in claims 47-60, 119-123, 135, 138 discussed above, therefore are rejected by the same rationale.

Conclusion

7.   Claims **47-60, 75-88, 103-116** and **119-139** are rejected.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.   **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please

label   "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen
October 17, 2003
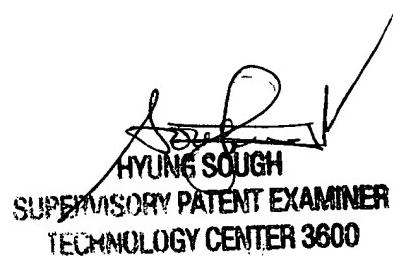
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